



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/566,555

01/27/2006

Menno Willem Jose Prins

NL030947

6159

24737

7590

08/06/2008

PHILIPS INTELLECTUAL PROPERTY & STANDARDS

P.O. BOX 3001

BRIARCLIFF MANOR, NY 10510

EXAMINER

DO, PENSEE T

ART UNIT

PAPER NUMBER

1641

MAIL DATE

DELIVERY MODE

08/06/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/566,555	Applicant(s) PRINS, MENNO WILLEM JOSE	
	Examiner Pensee T. Do	Art Unit 1641	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 April 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/19/07, 1/27/06</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of group II, claims 18-25 in the reply filed on April 24, 2008 is acknowledged.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 18-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The language of claim 18 is construed to invoke 35 USC 112, sixth paragraph, because it meets the 3-prong analysis as set forth in MPEP, section 2181:

- (A) the claim limitations must use the phrase "means for" or "step for;"
- (B) the "means for" or "step for" must be modified by functional language; and
- (C) the phrase "means for" or "step for" must not be modified by sufficient structure, material, or acts for achieving the specified function.

MPEP 2181 states that : 35 U.S.C. 112, sixth paragraph states that a claim limitation expressed in means-plus-function language "shall be construed to cover the corresponding structure...described in the specification and equivalents thereof." "If one employs means plus function language in a claim, one must set forth in the specification an adequate disclosure showing what is meant by that language. If an applicant fails to set forth an adequate disclosure, the applicant has in effect failed to particularly point out and distinctly claim the invention as required by the second paragraph of section 112." In re Donaldson Co., 16 F.3d 1189,1195, 29 USPQ2d 1845, 1850 (Fed. Cir. 1994) (in banc).

Claim 18 recites a means to distinguish between the bindings of different strengths. However, the specification fails contain an adequate disclosure showing what is meant by "means to distinguish between the bindings of different strengths".

Claim 22 also invokes 35 USC 112, sixth paragraph. Claim 22 recites "means for exerting a fluid frictional force". However, the specification fails to contain an adequate disclosure showing what is meant by "means for exerting a fluid frictional force". The specification also fails to provide any structure which describes the means for exerting a fluid frictional force.

Claim 24 also invokes 35 USC 112, sixth paragraph. Claim 24 recites "means for generating an excitation that forces a lateral movement of the particles with respect to the array". The specification fails to provide an adequate disclosure showing what is meant by "means for generating an excitation that forces a lateral movement of the particles" or any structure which performs such function.

Claim 24 recites "the array" in line 3, which lacks antecedent basis. There is no array recited in claim 18.

Claim 25 provides for the use of the tool, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 25 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 18-21, 22, 24, 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Wilson (US 6,337,215).

Wilson teaches magnetic particles with different strengths of magnetic moments and/or different magnetic field dependencies for separating of several affinity partners simultaneously. Magnetic particles having different magnetic moments (magnetic particles with the first magnetic moment are equivalent to first particles; and magnetic particles with a second magnetic moment are equivalent to second particles of the present invention) are attached to different acceptor molecules (microbiological entity such as protein or peptide- see col. 16, lines 55-65; col. 19, lines 58-60) and a magnetic field generator (see col. 1, line 65-col. 2, line 28). When the particles are separated using a magnetic force, the application of such magnetic force draws the magnetic beads of same magnetic moments into a region determined by the magnetic field so that non-magnetic components can be eliminated. Beads with different magnetic moments are caused to move at different rates and thus the strengths of the particles are distinguished. Regarding claims 22 and 24, since the present invention describes that the magnetic field generator is a means for exerting a mechanical stress, which also includes a means for exerting a fluid frictional force and means for generating an excitation that forces a lateral movement of the particles and Wilson teaches a magnetic field generator, such magnetic field generator is capable

Art Unit: 1641

of exerting a fluid frictional force since Wilson teaches the particles are placed in a solution (see col. 16, lines 14-25 or fig. 7) and generating an excitation that forces the particles to move laterally.

Claims 18-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Baselt et al. (Biosensors & Bioelectronics 13, 731-739, 1998).

Baselt teaches a biosensor that measures forces that bind DNA to DNA, antibody-antigen or ligand to receptor together. The bead array counter (BARC) use these interaction forces to hold magnetic microbeads to a solid substrate. Microfabricated magnetoresistive transducers on the substrate indicate whether or not the beads are removed when pulled by magnetic forces. By adapting magnetoresistive computer memory technology, it is possible to fabricate millions of transducers on a chip and detect or screen thousands of analytes. (see abstract). Since Baselt teaches that multi- analytes are detected or screened, there must be more than one types of magnetic particles, one type for each different analyte. Baselt teaches that the target molecule bridges the substrate and a magnetic microbead. (see pg 733, magnetic bead assays). Thus, the magnetic beads are attached to the target molecule which is an antigen (protein) or DNA.

Regarding claim 24, since the specification fails to describe any structure of the means for generating an excitation that forces a lateral movement of the particles with respect to the array, the magnetic field generator in Baselt is equivalent to such means because the magnetic field generator can be placed on any side of the substrate/array to attract the magnetic particles to move laterally towards the magnetic field. Regarding claims 22 and 24, since the present invention describes that the magnetic field generator is a means for exerting a mechanical stress, which also includes a means for exerting a fluid frictional force and means for generating an

Art Unit: 1641

excitation that forces a lateral movement of the particles and Baselt teaches a magnetic field generator, such magnetic field generator is capable of exerting a fluid frictional force and generating an excitation that forces the particles to move laterally.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pensee T. Do whose telephone number is 571-272-0819. The examiner can normally be reached on Monday-Friday, 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le can be reached on 571-272-0823. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Pensee T. Do/
Examiner, Art Unit 1641
July 30, 2008

/Mark L. Shibuya, Ph.D./
Supervisory Patent Examiner, Art Unit 1641